

REMARKS

Claims 1-6, 8, 9 and 11-15 are pending in the present application. Applicant appreciates the Examiner's courtesy in discussing the application over several telephone conversations. As discussed, the Examiner's Advisory Action incorrectly refers to an amendment. Moreover, the Advisory Action did not address in any manner Applicant's remarks submitted on July 22, 2004. It is believed that the claims as pending are in condition for allowance. Thus, to provide the Examiner an opportunity to reconsider, Applicant is submitting a request for continued examination to withdraw the application from appeal and reopen prosecution before the Examiner (see 37 CFR 1.114(d)). Applicant has generally pared (without prejudice) his arguments in this submission from the remarks submitted on July 22 for the Examiner's benefit. Reexamination and reconsideration are respectfully requested.

The present invention relates to an electronic toy and a method for controlling an electronic toy. The toy has a sensor that generates a detection signal. The toy can generate an accumulative empirical value on the basis of the signal and read out control information from the memory in accordance with the empirical value (see, e.g., steps 36 and 37 in Fig. 5).

Independent claim 1 is directed to an electronic toy and recites that "said processor is further adapted to generate an accumulative empirical value on the basis of the external stimulus detection signal generated by said sensor and read out control information from said memory in accordance with the empirical value." Independent claim 13 is directed to a method for controlling an electronic toy and includes a similar recitation.

In the final Office Action dated January 22, 2004, the Examiner rejected claim 1 and its dependent claims under 35 U.S.C. § 103(a) as being unpatentable over Kikinis (US 5746602) in view of Gabai et al. (US 5752880). However, the explanation of the rejection indicates that the Examiner believes that Kikinis anticipates every listed claim, except for dependent claim 12 for which Gabai is additionally cited. Similarly, the Examiner rejected claim 13 and claim 14 under § 103 as being unpatentable over Kikinis in view of Hampton et al. (US 6149490), but Hampton is

cited only for claim 14. Thus, Applicant construes the Office Action as rejecting independent claims 1 and 13 under § 102 based on Kikinis.

Applicant respectfully submits that Kikinis fails to disclose that “said processor is further adapted to generate an accumulative empirical value on the basis of the external stimulus detection signal generated by said sensor and read out control information from said memory in accordance with the empirical value” as recited in claim 1 and similarly recited in claim 13. Kikinis is directed to a doll 13 that is a peripheral of a computer 15. The computer essentially drives the doll 13 to perform certain operations. There is no disclosure or suggestion in Kikinis that the doll 13 has a processor that generates an accumulative empirical value on the basis of sensor signal and, then, reads out control information from the doll’s memory based on the empirical value. The Examiner in his “Response to Arguments” section cites Col. 5, line 17 to Col. 8, line 60 as disclosing this recitation. However, Applicant respectfully submits that the cited section does not provide any discussion regarding the generation or use of an empirical value.

Accordingly, Applicant respectfully submits that claims 1 and 13 are not anticipated by Kikinis for at least the reason set forth above.

Dependent claims 2-6, 8, 9, 11 and 15 are likewise not anticipated by Kikinis for at least the reason set forth above.

As discussed above, the Examiner rejected dependent claim 12 as being unpatentable over Kikinis and Gabai. Gabai is directed to a computer and toy system employing wireless communication there between. In the “Response to Arguments” section, the Examiner indicated that Gabai discloses the use of an empirical value at Col. 7, line 38 to Col. 8, line 65. However, Applicant has reviewed the cited section and no such disclosure is provided. Accordingly, claim 12 is patentable over Kikinis and Gabai for at least this reason.

Finally, the Examiner rejected claim 14 as being unpatentable in view of Kikinis and Hampton. Claim 14 is directed to a computer program run on a computer or processor in the electronic toy that performs the steps recited in claim 13. The Examiner cites Hampton as showing

an electronic toy with a processor. The toy in Hampton is compact and self-contained. While it has an infrared transmitter and receiver for sending and receiving information (see Fig. 44 at 1004 and 1008 and Col. 18, line 51 to Col. 19, line 5), Hampton does not appear to disclose the receipt and storage of programs from an outside source. The embodiment that is disclosed utilizes a pre-stored program in the toy (see, e.g., Col. 24, lines 46-50). Thus, Hampton is different from Kikinis in which a program in a separate PC drives the toy. There is no motivation to combine Kikinis with Hampton, because Hampton teaches away from utilizing a program in a separate PC to drive the toy. Accordingly, Applicant respectfully submits that the Examiner has failed to make a prima facie case of obviousness for at least this reason.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. If, for any reason, the Examiner finds the application other than in condition for allowance, Applicant requests that the Examiner contact the undersigned attorney at the Los Angeles telephone number (213) 892-5630 to discuss any steps necessary to place the application in condition for allowance.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 393032029100.

Dated: December 22, 2004

Respectfully submitted,

By 

Mehran Arjomand

Registration No.: 48,231

MORRISON & FOERSTER LLP
555 West Fifth Street, Suite 3500
Los Angeles, California 90013
(213) 892-5630